

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Initially, as requested by the Examiner, the cross reference to the parent applications has been updated to indicate the abandoned status of both parent applications.

The allowance of claims 1-6 is noted.

Claim 7 has been amended to require adding an aqueous C₂₋₄ alcohol to crystals of 1,2-benzisoxazole-3-methanesulfonamide containing residual 1,2-dichloroethane of more than 5 ppm and distilling the resulting mixture, which based on the disclosure on page 4 of the specification.

The rejection of claim 7 under the second paragraph of 35 U.S.C. §112 is respectfully traversed.

The Examiner takes the position that claim 7 fails to recite how the residual 1,2-dichloroethane is removed. However, although as noted by the Examiner, the claims measure the invention, it is the specification which teaches the art-skilled how to practice the claimed invention. *In re Roberts*, 176 USPQ 313.

The Examiner cites *In re Priest*, 199 USPQ 11, for the proposition that the invention is the subject matter defined by the claims, and no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim. Applicants agree, but it is not seen how this supports the rejection of claim 7 under the second paragraph of 35 U.S.C. §112. The statements quoted by the Examiner were made by the CCPA in response to an “inferential limitation” inserted into the claims by the Board of Appeals. The CCPA pointed out that the Board improperly added this inferential limitation to the claims in order to reach its decision, since no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim. In fact, quite to the contrary of the Examiner’s position in the present case, *Priest* also held that claims which particularly point out and distinctly claim the subject matter which applicant regards as his invention do comply with the second paragraph of 35 U.S.C. §112. Although the Examiner has rejected claim 7 under the second paragraph of 35 U.S.C.

§112, this claim does particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

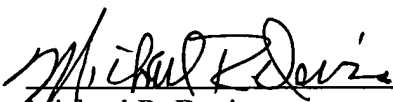
Nevertheless, claim 7 has been amended as discussed above, to even more particularly point out the claimed invention.

For these reasons, Applicants take the position that the rejection of claim 7 should be withdrawn.

Therefore, the application is considered to be in condition for allowance and such allowance is solicited.

Respectfully submitted,

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